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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,275	10/27/2003	Amanda Hoffnig	10005911-2	2787

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

GORDON, STEPHEN T

ART UNIT PAPER NUMBER

3612

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/694,275		HOFFNUNG, AMANDA	
	Examiner		Art Unit	
	Stephen Gordon		3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 and 33-36 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 27-30 and 33-36 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant should note, the following final action on the merits is deemed warranted to the extent that applicant's arguments in the latest amendment could be construed to refine the definition of previously presented claim terminology and thereby alter claim scope – i.e. estoppel.
2. The disclosure is objected to because of the following informalities: the status of the relied upon parent cited on page 1 should be updated to reflect the issued patent. Appropriate correction is required.
3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

New claim 35, line 2 is generally awkward and confusing. Specifically, the phrase "releasably secured the securing bracket" is not understood.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 27-29 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukui '943.

Regarding claims 27-29 and 30, these claims are rejected as anticipated by Tsukui '943 as detailed in paragraph 5 of the last office action.

Regarding applicant's remarks in the latest amendment directed toward this rejection as it applies to claim 27, it should be noted that applicant stresses that the '943 patent references the support surface as defining "the earth". As stated in the last office action, the examiner is relying on the teachings directed toward surface D comprising a floor/support surface – note section 3, line 8. Applicant additionally remarks that the floor D does not define a "packaging component". Applicant further emphasizes portions of the instant specification wherein the instant invention is used for shipping, and indicates a floor would not properly define a packaging component in such situations. Firstly it should be noted that nowhere in claim 27 is reference made to the device being used for shipping or transport. Moreover, nowhere in claim 27 is reference made to the packaging component being portable as such. It appears applicant is reading limitations into the broad claim terminology that are not recited. Additionally, in applicant's own specification, reference is made to use of the instant invention in a static/storage situation. Note specifically, on page 3 of applicant's specification, he indicates that a concern addressed by the instant invention is that caster wheels "can deform if the article 12 is *stored for a prolonged period of time*" (emphasis added). Additionally, in the background of the invention portion of the instant specification which

describes the problems that applicant is attempting to overcome, applicant indicates that the instant device relates to “packaging adequate to protect the systems during ... storage” (emphasis added). The examiner remains of the position that floor D of the ‘943 patent is fairly readable on a “packaging component” as *broadly claimed*. By way of example, if an item were placed on a warehouse floor for storage and covered by a tarp. Then if such tarp were secured to the warehouse floor, it would clearly be appropriate to refer to such an assembly as a “package”. Note Webster’s New Collegiate Dictionary (copyright 1980) defines a “package” as “a preassembled unit”. The floor in this case would clearly be part of the “package” and could fairly be called a “packaging component”. So to the extent that applicant specifically references use of his invention in the instant specification for storage applications and to the extent that applicant has not included language in claim 27 referencing shipping and/or the portability of the packaging component, the examiner remains of the position that Tsukui ‘943 teaches a “packaging component” as broadly claimed.

Turning to applicant’s remarks directed toward the step of “securing” in instant claim 27, the examiner is not entirely clear as to why applicant would consider a broad recitation of “securing” to include use of a fastener as such. Applicant indicates in the remarks of the latest amendment that “Tsukui teaches away from ‘securing’ a caster because...Tsukui is positioned on floor surfaces where, presumably, use of a fastener or the like would not be feasible.” Applicant goes on to say “Tsukui does not teach or suggest any securing mechanism.” Clearly, the term “securing” as typically defined in the art does not require use of a fastener as defined by applicant. Webster’s New

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Collegiate Dictionary (copyright 1980) defines "secure" as "to hold fast" or "to make fast". The caster bracket of Tsukui is taught as comprising a highly frictional material or a roughened surface to engage the support surface/floor D to prevent the associated caster from moving. Clearly such function would define "securing" as broadly claimed. Again it appears applicant is reading limitations into the broad claim terminology that are not recited/required. Nowhere in instant claim 27 is a fastener as such recited to provide for the claimed securing.

Regarding applicant's remarks in the latest amendment directed toward this rejection as it applies to claim 33, applicant indicates primarily that Tsukui '943 fails to teach the fastening step as such. As noted in the last office action, Webster's New Collegiate Dictionary (copyright 1980) defines "fasten" as "to make...secure"; "to take a firm grip or hold"; and "to set...steady". The designed in high friction contact provided between the securing bracket 12 and the support surface D of Tsukui is deemed to define fastening as broadly claimed – see for example, section 2, lines 53-57 and section 3, lines 44-48 etc of Tsukui. Clearly the designed in high friction contact of Tsukui would serve "to make secure" or "to take a firm grip or hold" or "to set steady" and thereby fasten as broadly claimed.

Applicant does not specifically provide additional arguments with respect to the rejection of claims 28-29 beyond the arguments directed to the base claim 27.

6. Claims 27, 30, and 34-36, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hagar '346.

Applicant should note, the following final rejections for at least claims 27 and 30 are deemed warranted to the extent that applicant's arguments in the latest amendment could be construed to refine the definition of previously presented claim terminology and thereby alter claim scope – i.e. estoppel.

Hagar teaches a caster securing bracket 41+ secured to a mobile transport platform (12-figure 1) and fastened in place via bolts (51,52) which extend through apertures in the platform and the bracket (see figure 2).

Claim 27, the securing bracket assembly 41+ is moved into a relative position wherein it resides between the caster and the packaging component/platform 12. Further, the securing bracket is secured to the package component via a bolt 52.

New claims 34 and 35, the bolts fixedly and releasably secure as best understood and as broadly claimed.

New claim 36, the packaging component is deemed to define a portion of a shipping container as broadly claimed. Moreover, in as much as the limitation of the shipping container per se does not affect the claimed method in a manipulative sense, the language relating thereto is given little patentable weight.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz Jr in view of Kuhl.

Regarding claim 30, the claim is rejected as being unpatentable over Schultz Jr in view of Kuhl as detailed in paragraph 7 of the last office action.

Regarding applicant's remarks in the latest amendment directed toward this rejection, it is noted that applicant argues that neither Schultz Jr or Kuhl teach attachment to a shipping container. Neither claim 30 or base claim 27 recite a shipping container, and applicant's arguments appear to be misdirected and are not understood. To the extent that applicant argues that the floor of Schultz Jr does not comprise a "packaging component" as such, the examiner remains of the position that such element is deemed fairly readable on a packaging component. Applicant's attention is directed to the discussion regarding reading of a floor on the packaging component as discussed above in the section 102 rejection of claim 27.

9. Applicant's arguments filed 6-10-05 as they apply to the rejected claims have been fully considered but they are not persuasive.

Regarding applicant's remarks directed toward the art rejections introduced in the last office action and currently maintained, the examiner has responded to these arguments in detail above in the appropriate sections of the 35USC 102 and 103 rejections. In

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general, it appears applicant is arguing limitations into the broad claim language that are not recited. Specifically it is noted, the instant claims do not specify a method of *shipping*, a *portable/mobile* packaging component as such, and/or a fastener required for *the broad step of securing* as discussed above. Applicant seems to be relying on these concepts for patentability, and such concepts are not included in the claim language. While it may or may not be that such recitations would begin to move away from the teachings of the relied upon prior art, in as much as they are not present in the instant claims, it is not deemed proper at this time to hinge patentability on such related arguments alone.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gordon whose telephone number is (571) 272-6661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen Gordon
Primary Examiner
Art Unit 3612

stg